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EXAMINER

SORKIN, DAVID L

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 12/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/579,938

Applicant(s)

WILLIAMS, TIMOTHY J

Examiner

David L. Sorkin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 11 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1,3-7,9-11 and 13-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,3-7,9-11 and 13-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 1, 3-7, 9-11 and 13-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. The examiner has attempted to make constructive suggestions for alleviating the section 112 rejections. The suggestions below are not meant to address any rejections under section 102 or 103, but only section 112.
4. Independent claims 1, 7, 11 and 16 are each rendered indefinite by the phrase "for holding the paint storage compartments". If the word "for" were deleted from each instance of this phrase, this ground for rejection would be withdrawn, because it would be clear that, in the claimed apparatus, the frame (claims 1, 7, or 11) or body (claim 16) is actually required to hold the paint compartments. Currently, it is unclear what structural relationship, if any, is required between the frame/body and the compartments. See *In re Collier*, 158 USPQ 266 (CCPA 1968) regarding the requirement to clearly set forth structural relationships among elements of a claimed apparatus.
5. Likewise, claims 7 and 11 are rendered indefinite by the phrase "for covering the paint storage compartments". Claim 7 is further rendered indefinite by the phrase "when the lids are covering the paint compartments". If the word "for" is deleted from

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each instance of "for covering the paint storage compartments", and "when the lids are covering the paint compartments" is deleted from claim 7, this ground for rejection would be withdrawn.

6. Likewise, claim 5 is rendered indefinite by the phrases "for selectively covering the paint storage compartments" and "when the lids are covering the paint storage compartments". It is suggested that "for selectively" and "when the lids are covering the paint storage compartments" be deleted.

7. Claim 16 is considered indefinite because the phrase "when the lids are positioned over the paint compartments" appears to contradict the positive recitation "lids removably coupled to the paint compartments". It is suggested that "when the lids are positioned over the paint compartments" be deleted.

8. The scope of independent claim 22 is particularly unclear. The claimed container is recited as comprising four structural elements (a. a body, b. a lid, c. a stirring mechanism and d. a fan). A paint compartment is not one of the explicitly recited elements. However, it is recited that the body "is for holding paint in a plurality of paint compartments". This statement appears to be a recitation of an intended use. On the other hand, it is recited that the lid is "removably coupled to the paint compartments", which appears to be a recitation of a structural relationship. The claims must particularly point out whether or not a paint compartment is required. If a no paint compartment is required, structural statements concerning paint compartments (such as "coupled to the paint compartment", "positioned over the paint compartment" and "extending into a paint compartment") must be avoided. If paint compartments are

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required, the apparatus should be explicitly recited as comprising the paint compartments. It is suggested that part "a" of claim 22 read - - a body having a first side, a second side, and a plurality of integral paint compartments, each of said paint compartments having a front, a back, planar first side and a planar second side - -, and that in part "c" of the claim "when the lid is positioned over the corresponding paint compartment" be deleted and "to extend" read - - extending - -.

9. In claims 4 and 9, there is lack of antecedent basis for "the back" of the frame. However, if the above suggestions are followed, establishing a clear structural relationship between the "compartments" and the frame, it will be understood the back of the frame corresponds to the back(s) of the compartments. Applicant may also wish to provide explicit antecedent basis for "the back" of the frame (as is done in claim 16). Alternatively, the references to the back of the frame could be dropped altogether (as is done in claim 14).

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2)(a) of such treaty in the English language.

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11. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Mullen et al. (US 5,673,817). Regarding claim 1 Mullen ('817) discloses an apparatus (11) comprising compartments (18,19,20) each having a front, a back, a first side, a second side and a base; a frame (13) configured for holding the paint storage compartments; and means (25) for dispensing removably coupled to the paint storage compartments (see col. 4, lines 42-53). While claim discusses "paint", "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, 164 USPQ 666, 667 (Bd. App. 1969). Regarding claim 3, the means for dispensing is a spigot assembly (see col. 5, line lines 6 and 7).

12. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by DeVito (US 5,842,606). Regarding claim 1, DeVito discloses an apparatus comprising a plurality of compartments (a plurality of 34) having a front, a back, a first side, a second side and a base; a frame (a plurality of 12 joined together as disclosed) for holding the paint storage compartments; and means (52) for dispensing removably coupled to the paint storage compartments. While claim discusses "paint", "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, 164 USPQ 666, 667 (Bd. App. 1969). Regarding claim 3, the means for dispensing paint includes a spigot assembly (see Fig. 5). Regarding claim 4, the frame includes mounting slots (38).

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13. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Briggs (US 6,109,482). Regarding claim 1, Briggs ('482) discloses an apparatus comprising a plurality of compartments (see Fig. 5); a frame (a plurality of 12 joined together as shown in Fig. 2) for holding the paint storage compartments; and means (22) for dispensing removably coupled to the paint storage compartments for dispensing paint from the paint storage compartments, wherein the means for dispensing is capable of dispensing paint without lifting the paint compartments. While claim discusses "paint", "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, 164 USPQ 666, 667 (Bd. App. 1969). Regarding claim 3, the means for dispensing paint includes a spigot assembly (see Fig. 3). Regarding claim 4, the frame includes mounting slots (42).

14. Claims 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Lande (US 5,829,344). Regarding claim 22, Lande ('344) discloses a container (10) comprising a body (12) having a first (16) and second (20) side; a lid (40), removably coupled to the paint compartments having an outer side, an inner opposite side and an aperture (48) located through the lid from the outer side to the inner opposite side; a stirring mechanism removably coupled to the outer side of the lid having an integrally formed rod (50), wherein the rod is positioned through the aperture in the lid; and a fan apparatus (86) removably coupled to the rod of the stirring mechanism on the inner opposite side of the lid (see Fig. 1; col. 5, lines 32-58). Claim 22 includes a statement of what a portion of the container is for, "for holding paint within a plurality of integral

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paint compartments...". However, "recitation with respect to the manner in which the claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Claims 23, 24, 26 and 27 fail to further structurally limit the claimed apparatus because no paint compartment is positively recited as part of the claimed apparatus. Regarding claim 25, the stirring mechanism has a handle (52,53; see col. 6, lines 44-47).

15. Claims 7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Reed et al. (US 4,311,017). Regarding claim 7, Reed ('017) discloses an apparatus comprising a plurality of compartments (24,27), each having a front, a back, a planar first side and a planar second side and a base (see Fig. 2, 3 and 5; col. 3, lines 15 and 16); a frame (2) for holding the compartments; lids (25,26 and/or 3); and a stirring assembly (111,112,113,114) removably coupled to the lid(s). While claim discusses "paint", "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, 164 USPQ 666, 667 (Bd. App. 1969). Regarding claim 9, the frame includes slots (101').

### ***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



17. Claims 1, 3-6, 10, 11, 13-19 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reed et al. (US 4,311,017). Regarding claim 1, Reed ('017) discloses an apparatus comprising a plurality of compartments (24,27), each having a front, a back, a first side, a second side and a base (see Fig. 2, 3 and 5; col. 3, lines 15 and 16); a frame (2) for holding the compartments; and means (15,16) for dispensing. While it is not explicitly stated that the dispensing means is removable (although Fig. 3 appears to depict a hex nut), the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 3, the dispensing means is a spigot assembly (see col. 5, lines 11-37). Regarding claim 4, the frame includes slots (101'). Regarding claim 5, one or more removable lids (25, 26 and/or 3) selectively cover the paint compartments, and means for stirring (111,112,113,114) are removably coupled to the lids. Regarding claim 6, the stirring means further comprises a circular base (111' or 114) a rod (112) coupled to the base, and a stirring fan apparatus (113) coupled to the rod. While it is not explicitly stated that the stirring fan apparatus is removable, the reference recognizes advantages of making parts removable (see col. 5, lines 35-37). Furthermore, it has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 10, the stirring means further comprises a circular base (111' or 114) a rod (112) coupled to the base, and a stirring fan apparatus (113) coupled to the rod. While it is not explicitly stated that the stirring fan apparatus is removable, the reference recognizes advantages of making parts removable (see col. 5, lines 35-37).

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Furthermore, it is has been held that making parts removable "would be obvious". *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 11, Reed ('017) discloses an apparatus comprising a plurality of compartments (24,27), each having a front, a back, a first side, a second side and a base (see Fig. 2, 3 and 5; col. 3, lines 15 and 16); a frame (2) for holding the compartments; a dispensing mechanism (15,16) one or more removable lids (25, 26 and/or 3) for covering the paint compartments and a stirring assembly (111,112,113,114) removably coupled to the lids. While it is not explicitly stated that the dispensing means is removable (although Fig. 3 appears to depict a hex nut), the reference recognizes advantages, of making parts removable (see col. 5, lines 35-37). Furthermore, it is has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 13, the dispensing mechanism includes a spigot assembly (see col. 5, lines 11-37). Regarding claim 14, the frame includes slots (101'). Regarding claim 15, the stirring assembly further comprises a circular base (111' or 114) a rod (112) coupled to the base, and a stirring fan apparatus (113) coupled to the rod. While it is not explicitly stated that the stirring fan apparatus is removable, the reference recognizes advantages, of making parts removable (see col. 5, lines 35-37). Furthermore, it is has been held that making parts removable "would be obvious", *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 16, Reed ('017) discloses a reusable container comprising a plurality of compartments (24,27); body (2) for holding the paint compartments having a front, a back, a planar first side and a planar second side (see Fig. 1); one or more removable lids (25, 26 and/or 3) coupled to the paint compartments having an outer side, an inner

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opposite side and an aperture located through the lid from the outer side to the inner opposite side; a stirring mechanism (111,112,113,114) removably coupled to the outer side of the lids having an integrally formed rod located at a central axis of the stirring mechanism, wherein the rod (112) is positioned through the aperture in the lids; and a stirring fan apparatus (113) coupled to the rod of the stirring mechanism on the inner opposite side of the lids. While it is not explicitly stated that the fan apparatus is removable, the reference recognizes advantages, of making parts removable (see col. 5, lines 35-37). Furthermore, it is has been held that making parts removable "would be obvious". *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Regarding claim 17, the body includes slots (101'). Regarding claim 18, the stirring mechanism includes a handle (see col. 6, lines 1 and 15-21). Regarding claim 19, the interior of the paint compartments has a sloped area and a reservoir area (see Figs. 2 and 3). Regarding claim 22, Reed ('017) discloses a reusable container comprising a body (2) having a first side and a second side for holding the paint compartments (24,27) (which are not positively recited as part of the claimed apparatus as discussed above regarding section 112); one or more removable lids (25, 26 and/or 3) coupled to the paint compartments having an outer side, an inner opposite side and an aperture located through the lid from the outer side to the inner opposite side; a stirring mechanism (111,112,113,114) removably coupled to the outer side of the lids having an integrally formed rod located at a central axis of the stirring mechanism, wherein the rod (112) is positioned through the aperture in the lids; and a fan apparatus (113) coupled to the rod of the stirring mechanism on the inner opposite side of the lids. While it is not explicitly stated that the

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fan apparatus is removable, the reference recognizes advantages, of making parts removable (see col. 5, lines 35-37). Furthermore, it is has been held that making parts removable "would be obvious". *In re Dulberg*, 129 USPQ 349 (CCPA 1961). Claims 23, 24, 26 and 27 fail to further structurally limit the claimed apparatus because no paint compartment is positively recited as part of the claimed apparatus. Regarding claim 25 the stirring mechanism includes a handle (see col. 6, lines 1 and 15-21).

18. Claims 21 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reed et al. (US 4,311,017) in view of Briggs (US 6,109,482). The apparatus of Reed ('017), discussed above regarding claim 16, fails to include rounded ribs and channels. Briggs ('482) discloses rounded ribs (44) and channels/grooves (42). It is considered that it would have been obvious to one of ordinary skill in the art to have provided the apparatus of Landa ('344) with ribs and channels/grooves as taught by Briggs ('482), because Briggs ('482) states that such ribs and grooves provided the benefit of allowing removable side-by-side coupling of a plurality of unit apparatuses (see col. 5, lines 13-32).

19. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lande (US 5,829,344) in view of Briggs (US 6,109,482). The apparatus of Lande ('344), discussed above regarding claim 22, fails to include rounded ribs and channels. Briggs ('482) discloses rounded ribs (44) and channels/grooves (42). It is considered that it would have been obvious to one of ordinary skill in the art to have provided the apparatus of Lande ('344) with ribs and channels/grooves as taught by Briggs ('482), because Briggs ('482) states that such ribs and grooves provided the benefit of allowing

removable side-by-side coupling of a plurality of unit apparatuses (see col. 5, lines 13-32).

***Allowable Subject Matter***

20. Claim 20 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, second paragraph in the manner suggested by the examiner above, and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

21. Applicant discusses materials such as paint and beverages as they related to respective intended uses of the instant invention and several prior art references. However, "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim". *Ex parte Thilbault*, supra.

22. Applicant fails to set forth any structural distinction between any of Mullen ('817), Devito ('817) and Briggs ('482) and the corresponding claims rejected under section 102. Instead, applicant discussed intended uses, such as what is intended to be stored or dispensed and discusses limitations which are not recited in the corresponding rejected claims, such as "formed in downward sloping configuration with each compartment having a spigot coupled to the base" (furthermore, Devito and Briggs both disclose exactly such a structure).

23. The examiner agrees that Parmeley ('429), Stephens ('936), and Lande ('344) do not disclose a *plurality* of compartments (although claim 22 fails to clearly positively recite a plurality of compartments).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 8:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
David Sorkin

November 22, 2002

  
**TONY G. SOOHOO**  
**PRIMARY EXAMINER**